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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,179	10/16/2003	Robert E. Williams JR.	7348	9546

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EXAMINER

SILBERMANN, JOANNE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/688,179

Applicant(s)

WILLIAMS, ROBERT E.

Examiner

Joanne Silbermann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 9, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whipp, US #5,792,536.

3. Whipp teaches separable tags having upper and bottom layers 4 and 6 and neck portion 10 (Figure 1). A series of tags linked together in a roll but separable at each neck is shown in Figure 4). The neck is capable of being connected to a container. Upper layer 6 is connected to lower layer 4 by adhesive 8 (Figure 3).

4. Layers 4 and 6 may be made of paper or plastic (column 2 lines 26-65) and may be imprinted with indicia (column 3 lines 47-52).

5. The neck of the tag shown by Whipp is narrower than the tag bottom portion and extends upwardly from the bottom portion approximately centrally thereof, however the size of the neck is not "substantially" narrower than the bottom portion. It would have been an obvious matter of design choice to make the neck narrower since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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6. Whipp does not specifically describe a release coat, however this is common in the art of adhesive, as in layer 14 of Whipp. It would have been obvious to one of ordinary skill in the art to use such a release layer between layers 4 and 6 if it si desired to use an adhesive that is not pressure sensitive.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whipp as applied to claim 14 above, and further in view of Kinne, US #3,863,369.

8. Whipp does not teach a cut line between the bottom portion and the neck, however this is considered to be an equivalent of a perforation. Kinne teaches cut line 14 for allowing separation of the parts of a label. It would have been obvious to one of ordinary skill to utilize such a line cut instead of a perforation as an equivalent alternative.

9. As discussed above, the top layer may be peeled from the bottom layer through adhesive 8.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whipp as applied to claim 14 above, and further in view of Heuser, US #2,953,865.

11. Whipp does not teach separating the tags from each other by perforation, however this is well known in the art as shown by Heuser. Heuser teaches a series of labels separated by perforations 11. It would have been obvious to one of ordinary skill in the art to connect the series by perforations instead of a base sheet so that the labels may be separated from each other without exposing the adhesive.

***Response to Arguments***

12. Applicant's arguments filed June 6, 2005 have been fully considered but they are not persuasive.

13. Applicant argues that the tags shown by Whipp (and as modified above) do not provide the same type of tag as the instant invention. As discussed in the above rejection, the specific size of the neck would have been an obvious change in size to a person having ordinary skill in the art. Applicant also argues that the tags of Whipp are not integrally connected together, however, this is shown in Whipp, Figure 4.

Applicant's arguments appear to be much narrower than the instant claim language.

14. Applicant states that Whipp does not suggest towards applicant's invention and that some teaching is required to establish obviousness. The examiner recognizes that references cannot be arbitrarily combined and there must be some motivation to make the proposed combination. However, there is no requirement that a motivation be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). In this case, the combination of Whipp and Kinne provides tags having a different type of separation line.

15. Applicant argues that Heuser does not show the same type of tag as the instant invention. As discussed in the rejection, Heuser shows the use of perforations between tags. As discussed in Heuser column 2 lines 40-44, the tags are separable by means of perforations 11. The rejection does not state that Heuser shows tags with substantially narrower neck portions.

### **Conclusion**

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16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

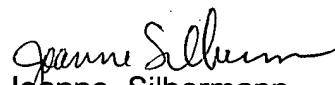
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

JS  
22 August 2005